REMARKS

This application has been carefully reviewed in light of the Office Action dated January 30, 2003 (Paper No. 20). Claims 1 to 31 are in the application, of which Claims 1, 10, 14, 26, 30 and 31, the independent claims, are being amended herein. Reconsideration and further examination are respectfully requested.

Claims 1 to 31 were rejected under 35 U.S.C. § 103(a) over excerpts from a book entitled "MS Exchange Users Handbook" (Mosher) in view of an IBM Technical Disclosure Bulletin entitled "Linking Handwriting Annotation with Text" (IBM) and further in view of U.S. Patent 5,590,257 (Forcier). The rejections are respectfully traversed.

The invention concerns information processing in which images for text data and ink data are overlaid. When an edit or insertion is made to the text data, the position of its image is affected. Without a change in the position of the ink image, which is reproduced from ink data, which includes a coordinate value of the reproduction position of the ink image, good relative positioning between images for the text and ink data cannot be maintained.

The present invention addresses the foregoing situation by calculating a coordinate shift amount for the reproduction position of the ink image (Claims 1, 14 and 30) or the locus image (Claims 10, 26 and 31). Thereafter, the ink image (or locus image) is output in a shifted position according to the calculated coordinate shift amount.

The applied art is not seen to disclosure or to suggest the foregoing arrangement, particularly as regards a calculation of a coordinate shift amount as well as an

output of an ink image (or locus image) overlaid on a text image at a position shifted according to the calculated coordinate shift amount.

The Office Action specifically concedes that Mosher does not disclose or suggest the foregoing, and implicitly concedes the same with respect to IBM. Rather, the Office Action relies on Forcier as allegedly teaching the foregoing feature. Applicants respectfully disagree.

Forcier is seen to describe inputting both handwritten character images and character images inputted from a keyboard to the same line, discriminating the boundaries of a handwritten character images and character images, and performing a wordwrap function on the displayed image. Forcier is not seen to disclose reproducing ink data overlaid on a text image at a reproduction position defined by a coordinate value shifted by a calculated coordinate shift amount.

The Office Action cites col. 21, lines 31 to 67, and indicates that this portion of Forcier teaches a relative and actual "X,Y" coordinate positon. The cited portion of Forcier is merely seen to describe determining whether or not a handwritten image that is being input falls on the current input line, and to describe that the position of the handwritten image on the current input line is relative to the input line's left margin and bottom-most raster row owned by the input line. In other words, the cited portion is merely seen to identify an input line on which a handwritten image being input falls. This is not seen to be the same as a coordinate value of the reproduction position of an ink image overlaid on a text image, and is certainly not seen to be the same as a coordinate shift

amount calculated according to a new text image reproduced from the text data to which the character string was inserted.

Thus, unlike the invention, Forcier does not calculate a coordinate shift amount for the output position of its handwritten annotations, nor does it output the handwritten annotations based on a calculated coordinate shift amount.

Applicants therefore respectfully submit that the applied art does not show at least the feature of calculating a coordinate shift amount for an ink image, as well as outputting an ink image at a position corresponding to the calculated coordinate shift amount.

Accordingly, independent Claims 1, 10, 14, 26, 30 and 31 are believed to be patentable over the applied art for at least the foregoing reasons. Withdrawal of the § 103(a) rejection is therefore respectfully requested.

The remaining claims are each dependent from the independent claims discussed above and are therefore believed patentable for the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of each on its own merits is respectfully requested.

In view of the foregoing, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Applicants' undersigned attorney may be reached in our Costa Mesa,

California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

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USPTO

Amendments in a Revised Format Now Permitted

Office of Patent Legal Administration << Pre-OG Notices << << Amendments in a Revised Format Now Permitted

The United States Patent and Trademark Office (USPTO or Office) is permitting applicants to submit amendments in a revised format as set forth herein. The revised amendment format is essentially the same as the amendment format that the Office is considering adopting via a revision to 37 CFR 1.121 (Manner of Making Amendments). The revision to 37 CFR 1.121 (if adopted) will simplify amendment submission and improve file management. The Office plans to adopt such a revision to 37 CFR 1.121 by July of 2003, at which point compliance with revised 37 CFR 1.121 will be mandatory.

The revised amendment format is an expansion of the special amendment process instituted for a prototype Electronic File Wrapper program described in USPTO ANNOUNCES PROTOTYPE OF IMAGE PROCESSING, 1265 Off. Gaz. Pat. Office 87 (Dec. 17, 2002) ("Prototype Announcement"). The special amendment process (which was limited to claims) has proven overwhelmingly acceptable to applicants participating in the prototype and beneficial to examiners. The revised amendment format provides for amendments to be made to the specification and the drawings in addition to the claims.

Effective immediately, **all** applicants, including applicants participating in the prototype, may submit amendments using the revised amendment format set forth herein. Applicants may wish to submit all amendments in the revised amendment format because: (1) it will facilitate transition to a revised amendment format when it becomes mandatory, (2) inconsistent versions of claim amendments (clean and marked-up) will be avoided, and (3) time and resources will be saved.

WAIVER of 37 CFR 1.121

The provisions of 37 CFR 1.121(a), (b), (c) and (d) are waived for amendments to the **claims, specification, and drawings** in all applications in all Technology Centers where the amendments comply with the revised amendment format detailed below. Note: The revised amendment format (and the waiver) does **not** apply to 37 CFR 1.121(h) and (i) which indicate that amendments to reissue applications and reexamination proceedings are governed by 37 CFR 1.173 for reissue applications and 37 CFR 1.530 (d)-(k) for *ex parte* and *inter partes* reexaminations.

In addition, the WAIVER indicated in the above mentioned Prototype Announcement for the limited (claims only) amendment process of that prototype is also expressly continued and amendments in applications (other than reissue applications) in all Technology Centers that comply with the requirements in that announcement will be acceptable.

REVISED AMENDMENT FORMAT

I. Begin Sections on Separate Sheets:
Each section of an amendment paper (e.g., Amendments to the Specification, Amendments to the Claims, Remarks) shall begin on a separate sheet to facilitate separate indexing and electronic scanning of the document.

For example, each of the following four sections of an amendment paper must start on a separate sheet:

    a.) Introductory Comments

b.) Amendments to the Specification
c.) Amendments to the Claims
d.) Remarks

II. Submit Only One Version (with markings) of an Amended Part:
The requirement to provide two versions of a replacement paragraph, section, or claim (a clean version and a marked up version), as set forth in current 37 CFR 1.121, is waived where the format set forth below is followed.

III. Amendments to the Claims

A.   A Complete Listing of Claims is Always Required:

If an amendment adds, changes or deletes any claim, a detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remains under examination in the application, must be presented, and the amendment to the claims is expressed in the listing. The listing shall be presented as follows:

1. Ascending Order and Status Identifier Required
The listing shall be provided in sequential ascending numerical order (beginning with claim 1). A status identifier shall be provided for every claim in a parenthetical expression following the claim number (e.g., "Claim 1. (original)"). A list of acceptable status identifiers is set forth in part B, below. The text of all claims under examination shall be submitted each time any claim is amended. Cancelled and withdrawn claims should be indicated by only the claim number and status. The text of cancelled or withdrawn claims should not be presented.

2. Markings in Currently Amended Claims Required
All claims *being currently amended* shall be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The changes in any amended claim should be shown by strikethrough (for deleted matter) or underlining (for added matter). No separate "clean" version should be submitted for currently amended claims, as this requirement has been eliminated. **Markings should only be made in claims being currently amended in an amendment paper.**

3. Only Clean Text Required for Other Claims Under Examination.
The text of pending claims *not being currently amended* that are under examination shall be presented in a clean version in the listing. Any claim presented in clean version constitutes an assertion that it has not been changed relative to the immediate prior version.

4. Status to Effect Claim Cancellation or Addition.
A claim may be cancelled by merely indicating the status of the claim as cancelled. Any new claim added by amendment must be indicated by the appropriate status identifier and shall not be underlined. Thus, added new claims of status (new), (reinstated - formerly claim #_) and (re-presented - formerly dependent claim #_) must be presented in clean version. Additional claims may be subject to additional fees, as appropriate.

5. When Grouping of Claims is Permitted.
Consecutive cancelled or withdrawn claims may be aggregated into one line of the listing (e.g. Claims 1 - 5 (cancelled)).

6. Use "Currently Amended" Status Where Applicable.
If any "previously reinstated" or "previously re-presented" claim is
being amended, the status shall be indicated as "currently amended"
with markings as indicated in paragraph A2, above. Multiple status
identifiers should not be used for any single claim.

B. Status Identifiers that May be Used:

In order to promote uniformity and consistency, only the following eleven (11) defined status
identifiers should be used to indicate the status of the claims (in parentheses after the claim
number):

1. (Original):	Claim filed with the application following the specification (i.e., not added by preliminary amendment).
2. (Currently amended):	Claim being amended in the current amendment paper.
3. (Previously amended):	Claim not being currently amended, but which was amended in a previous amendment paper.
4. (Cancelled):	Claim cancelled or deleted from the application.
5. (Withdrawn):	Claim still in the application, but in a non-elected status.
6. (Previously added):	Claim added in an earlier amendment paper.
7. (New):	Claim being added in the current amendment paper.
8. (Reinstated - formerly claim # _):	Claim deleted in an earlier amendment paper, but re-presented with a new claim number in current amendment.
9. (Previously reinstated):	Claim deleted in an earlier amendment and reinstated in an earlier amendment paper.
10. (Re-presented - formerly dependent claim # _):	Dependent claim re-presented in independent form in current amendment paper.
11. (Previously re-presented):	Dependent claim re-presented in independent form in an earlier amendment, but not currently amended.

C.   Example of Listing of Claims:

Claims 1-5 (cancelled)
Claim 6 (withdrawn)
Claim 7 (previously amended): A bucket with a handle.
Claim 8 (currently amended): A bucket with a ~~green~~ blue handle.
Claim 9 (withdrawn)
Claim 10 (original): A bucket with a wooden handle.
Claim 11 (cancelled)

Claim 12 (new): A bucket with plastic sides and bottom.
Claim 13 (previously added): A bucket having a circumferential upper lip.
Claim 14 (re-presented - formerly claim 11): A black bucket with a wooden handle.

IV. Amendments to the Specification

Amendments to the specification are to be made by presenting replacement paragraphs, sections or a substitute specification marked up to show changes made relative to the immediate prior version, as set out in 37 CFR 1.121(b). The changes should be shown by strikethrough (for deleted matter) or underlining (for added matter). No accompanying "clean" version shall be supplied. The amendments to the specification shall be presented only one time, and will not appear in successive amendment documents.

V. Amendments to the Drawings

Amendments to the drawing figures shall be made by presenting replacement figures which include the desired changes, without markings, and which comply with § 1.84. The changes shall be explained in the accompanying remarks section of the amendment paper. If the amended drawings are not approved, the applicant will be notified in the next Office action. Any amended drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure number in the amended drawing should not be labeled as "amended."

For further information on the prototype image electronic processing of patent applications, please contact the Search and Information Resources Administration at: **image.processing@uspto.gov**. Any questions regarding the submission of amendments pursuant to the revised practice set forth in this notice should be directed to Elizabeth Dougherty (**Elizabeth.Dougherty@uspto.gov**), Gena Jones (**Eugenia.Jones@uspto.gov**) or Joe Narcavage (mailto:**Joseph.Narcavage@uspto.gov**). For information on the waiver or legal aspects of the program, please contact Jay Lucas (**Jay.Lucas@uspto.gov**) or Rob Clarke (**Robert.Clarke@uspto.gov**).

Date: <u>1/31/03</u>

Signed: <u>/s/</u>
STEPHEN KUNIN
Deputy Commissioner for Patent
Examination Policy

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